In the Supreme Court of the United States

OCTOBER TERM, 1970.

No. 338.

BLONDER-TONGUE LABORATORIES, INC.,
Defendant and Counter Claimant-Appellant-Petitioner,
vs.
UNIVERSITY OF ILLINOIS FOUNDATION,
Plaintiff and Counterclaim Defendant-Appellee,
and
JFD ELECTRONICS CORPORATION,
Counterclaim-Defendant-Appellee, Respondents.

MOTION FOR LEAVE TO FILE BRIEF AMICUS CURIAE.

To The Honorable Chief Justice and Associate Justices of The Supreme Court of the United States:

The Finney Company, a manufacturer of radio and television antennas in Bedford, Ohio, respectfully moves for leave to file the annexed brief amicus curiae in connection with the Petition in the above case for a writ of certiorari to the United States Court of Appeals for the Seventh Circuit.

Consent to the filing of that brief has been refused by University of Illinois Foundation, Respondent to said Petition, speaking through its attorneys of record, thus necessitating the filing of this motion under Supreme Court Rule 42.

The movant, The Finney Company, is the plaintiff in a declaratory judgment action seeking, *inter alia*, a judgment that the Isbell patent of the University of Illinois

Foundation (the same Isbell patent involved in the above action) is invalid.[1] That declaratory judgment action is but one of several other suits involving the questions of validity and infringement of the Isbell patent.[2]

The annexed brief presents a persuasive reason, not presented by the Petitioner, for the Supreme Court to grant the requested writ. It has been filed as soon as possible after the Petition became available since it appears unlikely that either of the Respondents would present that reason why the Supreme Court should review the decision of the Court of Appeals for the Seventh Circuit.

As explained in the annexed brief, the conflicting decisions of the Courts of Appeals for the Seventh and Eighth Circuits diverge on an important question of law to which the Supreme Court has not specifically addressed itself heretofore. That question arises under the "obviousness" provision of 35 U.S.C. 103 and is the following:

> Where logical exploration within known principles of the art achieves an *unpredictable result*, does the necessity of logical experimentation, in and of itself, negate obviousness?

The Eighth Circuit Court of Appeals first answered that question "No" and held the Isbell patent in suit invalid. The Seventh Circuit Court of Appeals subsequently relied upon unpredictability of Isbell's success to reach the opposite result.

Clarification of the answer to that question should not only affect the suit in which The Finney Company is in-

---

[1] *The Finney Company v. JFD Electronics Corp. and University of Illinois Foundation*, Civil Action No. 65 C 671, United States, District Court for the Northern District of Illinois, Eastern Division.

[2] See Petition of Blonder-Tongue Laboratories, Inc., p. 9, note 2.

volved and the other pending suits on the same Isbell patent, but it should produce a better understanding and more consistent application of the law of patentability by the federal trial and appellate courts handling patent cases.

Accordingly, granting of this motion and consideration of the annexed brief are earnestly requested.

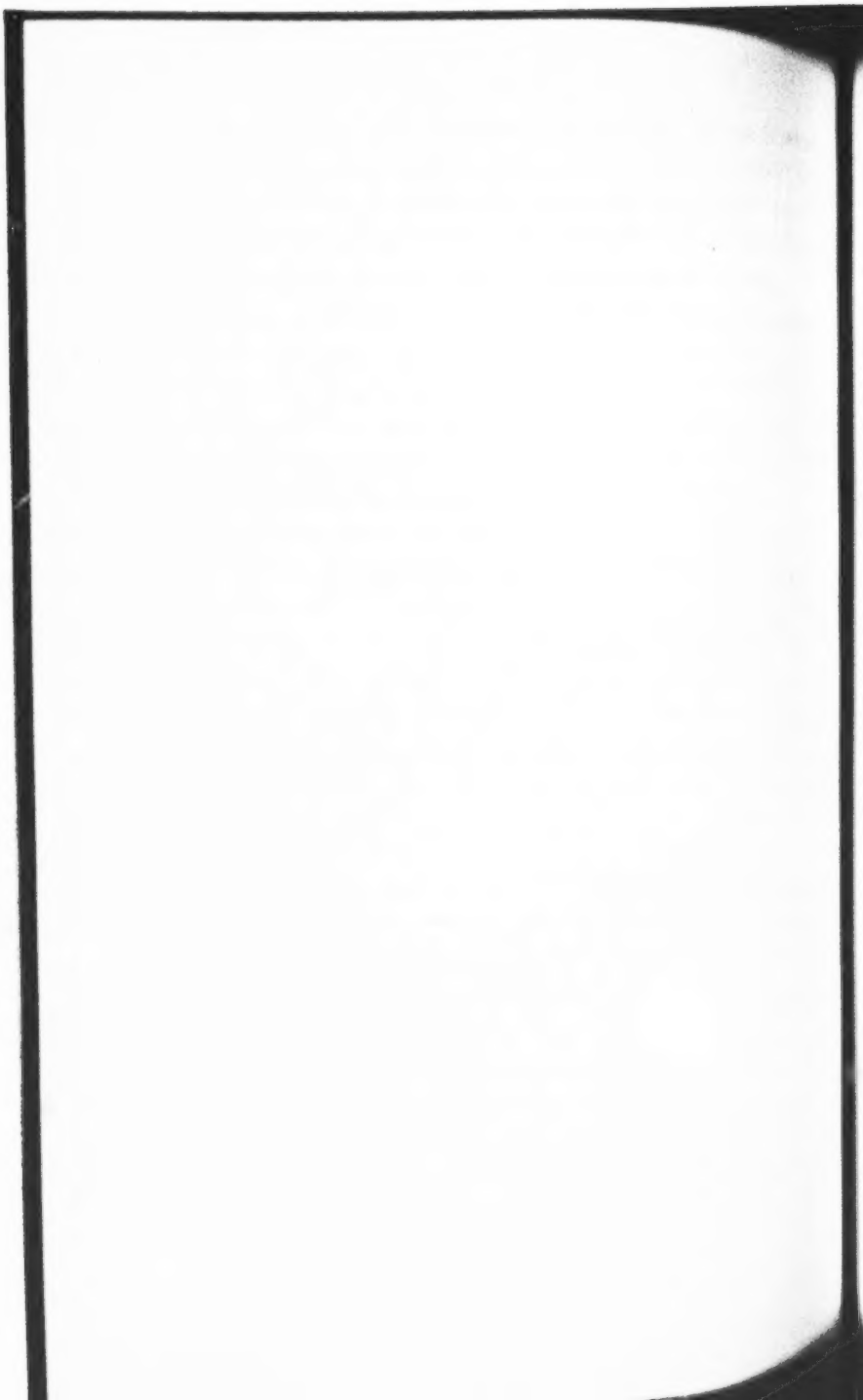
Respectfully submitted,

HAROLD F. MCNENNY,
JOHN F. PEARNE,
Attorneys for Amicus Curiae,
The Finney Company.

Of Counsel:

MCNENNY, FARRINGTON, PEARNE & GORDON,
920 Midland Building,
Cleveland, Ohio 44115,

WALTHER E. WYSS, ESQ.,
MASON, KOLEHMAINEN, RATHBURN & WYSS,
20 North Wacker Drive,
Chicago, Illinois 60606.



BRIEF AMICUS CURIAE OF THE FINNEY COMPANY SUPPORTING PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE SEVENTH CIRCUIT.

The Finney Company[1], as amicus curiae, respectfully supports the Petition in this case for a writ of certiorari to the United States Court of Appeals for the Seventh Circuit, for the additional reason that, despite a common understanding of the facts, the United States Courts of Appeals for the Seventh and Eighth Circuits, reached different and conflicting legal conclusions in applying the "obviousness" provision of 35 U.S.C. 103[2] to determinations of validity of the Isbell patent in suit. Such a conflict demonstrates an urgent need for further clarification of the meaning of that provision of the patent laws.

The history of this case and the other reasons for granting certiorari have been sufficiently set forth in the Petition of Blonder-Tongue Laboratories, Inc., Defendant and Counterclaim-Appellant below (pp. 1-6).

QUESTION PRESENTED.

Where logical exploration within known principles of the art achieves an unpredictable result, does the necessity of logical experimentation, in and of itself, negate obviousness?

The answer to that question of law, on which the Courts of Appeals of the Seventh and Eighth Circuits reached directly contrary conclusions, is the fundamental

---

[1] Declaratory judgment plaintiff in *The Finney Co. v. JFD Electronics Corp. and University of Illinois Foundation*, involving the Isbell patent here in suit and pending in the United States District Court for the Northern District of ~~Ohio~~ ILLINOIS, Eastern Division. See Petition, p. 9, note 2.

[2] Reproduced in the Petition, pp. 3-4.

point of divergence of their respective, conflicting opinions on validity of the Isbell patent in suit. The public importance of clarifying the answer to that frequently encountered question of law is indicated by the circumstance that both of the similarly conflicting District Court decisions below, which the two Courts of Appeals respectively affirmed, purported to apply 35 U.S.C. 103 to the same facts in the manner prescribed by the Supreme Court in *Graham v. John Deere Co.*, 383 U.S. 1, 12 (1966).[3]

DISCUSSION.

The invention of the Isbell patent relates to so-called "broadband" radio and television antennas and is alleged in the patent to produce uniform performance over a broad range of frequencies. Broadband antennas composed of similar arrangements of similar elements, called "dipoles," were old. It was also known to the prior art that certain types of broadband antenna structures could be given such uniform performance characteristics by proportioning them according to a so-called "log-periodic formula" (App. A7-A8, A42, and A51-A59).

Both Courts of Appeal had before them the same prior art (App. A8). Both Courts recognized that the significant difference between the antennas of the Isbell patent and the prior art antennas of similar character is that, according to the Isbell patent, the lengths and spacings of the successive dipoles vary progressively according to the log-periodic formula (App. A8 and A47). Both Courts referred to Jasik's Antenna Engineering

---

[3] See District Court decisions reproduced in the Appendix to the Petition, both citing *Graham v. John Deere* in this regard (App. A24 and A50).

handbook, which explained that the Isbell antenna was merely an adaptation of the log-periodic scaling principle to prior art broadband antennas to achieve uniform (i.e., frequency independent) performance over the frequency band (App. A10 and A43). As both Courts indicated by quotations from the Jasik handbook, whether or not a particular antenna, proportioned according to the log-periodic formula, would be frequency independent in its operation was simply determinable "by logical experimental methods" (App. 9A-10A and 47A).

However, both Courts also recognized from the evidence, as also stated in the Jasik handbook, that the frequency independent operation of the Isbell antenna (or any log-periodic antenna) was unpredictable, though verifiable by such simple, logical experimentation (App. A9, A44, and A47).

Based on such a common understanding of the facts, both the Seventh and Eighth Circuit Courts considered the crucial question to be whether it would have been obvious to a person having ordinary skill in the art to dimension the dipoles and dipole spacings of the prior art antennas according to the log-periodic formula.

The Eighth Circuit Court, noting that "the statutory standard of patentability under § 103 is not 'predictability'" (App. A44), stated—

> "Where logical exploration within known principles of the science achieves an unpredictable result, even though a commercially desirable one, the burden of nonobviousness is not necessarily overcome. In other words, the necessity of logical experimentation does not in and of itself negate obviousness." (App. A45-A46.)

Citing the Jasik handbook for support, the Eighth Circuit Court further stated (App. A47)—

> "The problem here was one of trial and error with a combination of commonly used elements operating within known principles of electronics and mechanics to achieve a desired result."

Accordingly, that Court affirmed the District Court below and held that (App. A48)—

> "The standard of patentability under § 103 requires more."

Based on the same understanding of the facts, the Seventh Circuit Court (App. A9-A10), like the District Court below (App. A25-A26), relied on the unpredictability of Isbell's success to arrive at the opposite conclusion that the Isbell invention was not obvious within the meaning of § 103 (App. A12).

The Supreme Court has heretofore ruled that the results of routine investigation, where the prior art pointed the way, do not involve invention. *Mandel Bros. v. Wallace,* 335 U.S. 293, 295-296 (1948). Cf. *Atlantic Works v. Brady,* 107 U.S. 192, 199-200 (1882). But that was prior to the present patent statute and prior to the Supreme Court's decision in *Graham v. John Deere Co., supra,* making "obviousness" the sole test of patentability where an element of novelty over the prior art exists.

Thus, it would seem to remain for the Supreme Court to settle the question of law first posed above. Apart from the need to resolve conflicting appellate decisions that have left an important patent valid in one circuit and invalid in another, settling that important question of law in this case should go far toward producing a better understanding and more uniform application of 35 U.S.C. 103 on which patentability depends in the majority of patent cases.

For the foregoing reasons, it is urged that the Petition of Blonder-Tongue Laboratories, Inc. in this case be granted.

Respectfully submitted,

HAROLD F. MCNENNY,
JOHN F. PEARNE,
Attorneys for Amicus Curiae,
The Finney Company.

Of Counsel:
MCNENNY, FARRINGTON, PEARNE & GORDON,
920 Midland Building,
Cleveland, Ohio 44115,
WALTHER E. WYSS, ESQ.,
MASON, KOLEHMAINEN, RATHBURN & WYSS,
20 North Wacker Drive,
Chicago, Illinois 60606.

Certificate of Service.

Service of copies of the foregoing BRIEF AMICUS CURIAE has been made this 8th day of July, 1970, upon all parties to the entitled action by depositing copies thereof in a United States Post Office, with first class air mail postage prepaid, respectively addressed to counsel of record for each of said parties.

HAROLD F. MCNENNY,
Counsel for Amicus Curiae,
The Finney Co.